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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-924,017	08/07/2001	Carl J. Pacifico	1001-3	3051

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EXAMINER

TRAN LIEN, THUY

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/924,017

Applicant(s)
Pacifico

Examiner
Lien Tran

Art Unit
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 6, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant amended claim 1 to add the limitation "wherein said ingredient possesses a leach rate greater than twenty-five percent". The limitation is not supported by the original disclosure. A rate greater than twenty five percent includes any rate above 25. The specification discloses one rate of 95%; there is no disclosure of any other rate. There is no disclosure of any range of leach rate; there is no evidence in the specification to indicate the claimed ingredient encompasses rates such as 34, 58, 96, 44 etc... A disclosure of one rate does not provide support for the range that is now claimed.

2. The 112 second paragraph rejection of claims 3-4, 7-9, 17-18 and 21-23 is hereby withdrawn.

3. Claims 1-11, 13-25, 27-28 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al for the same reason set forth in paragraph 4 of the previous office action and for the additional reason set forth below.

The new limitation on the leach rate does not define over Katz et al because such property is inherent in the Katz et al product. Katz et al disclose the same ingredient with the same coating material; thus, it is inherent that it would have the same property. Applicant discloses in the specification the coating material includes hydrogenated vegetable oil; Katz et al disclose

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hydrogenated vegetable oil as the coating material. Katz et al do not disclose the coating is continuous. Applicant does not disclose how the coating is made to be porous. If the same material is used, it is inherent the same property is obtained.

4. Claims 12, 26 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al for the same reason set forth in paragraph 7 of the previous office action.

5. In the response filed March 6, 2003, applicant argues Katz discloses a continuous coating coated by fluid bed technique as stated in the background of the invention. This argument is not persuasive. Katz et al do not disclose the coating is continuous and they do not disclose the coating is formed by fluid bed technique. Applicant did not disclose in the specification that the prior art discussed in paragraphs 4-6 is the Katz et al disclosure. Applicant argues Katz et al do not disclose microporous lipid coating. Katz et al disclose the same coating material as disclosed in the specification. Applicant has not disclosed in the specification how the coating is made to be porous; thus, the porosity must be an inherent property of the coating material. Therefore, if the same coating material is used, it is inherent the same porosity is obtained. Applicant discloses in paragraph 0011 that spray chilling gives a coating that is non-porous; yet, in paragraph 0021, applicant discloses the microporous lipid coating is formed by spray chilling. Thus, the method of how the coating is made does not give the porosity.

With respect to the 103 rejection, applicant makes the same argument as above and the argument is not persuasive for the same reason set forth above.

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6. Applicant's arguments filed March 6, 2003 have been fully considered but they are not persuasive.

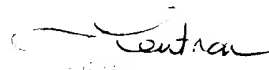
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is 703-308-1868. The examiner can normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

May 22, 2003


Lien Tran
PRIMER
Group 1700